

**REMARKS**

Claims 1, 3, 6, 11 - 15, and 18 - 19 have been amended (and these amendments are not made in response to the cited reference). No new matter has been introduced with these amendments, all of which are supported in the specification as originally filed. Claims 1 - 8 and 10 - 19 remain in the application.

I. **Rejection under 35 U.S.C. §112, second paragraph**

Paragraph 3 of the Office Action dated February 13, 2006 (hereinafter, "the Office Action") states that Claims 1 and 18 - 19 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. In particular, the phrases "comparing a manner ..." and "what manner of swiping ..." are considered problematic. Applicants have amended the claim language of the independent claims herein to clarify this claimed subject matter (and several of the dependent claims are then amended to align with the revised claim language in the independent claims), and the Examiner is therefore respectfully requested to withdraw the §112 rejection.

II. **Rejection under 35 U.S.C. §102(e)**

Paragraph 5 of the Office Action states that Claims 1 - 5, 7 - 8, and 10 - 19 are rejected under 35 U.S.C. §102(e) as being anticipated by U. S. Patent 6,792,430 to Kenyon et al. (hereinafter, "Kenyon"). Applicants respectfully submit that a *prima facie* case of anticipation under 35 U.S.C. §102 has not been made out, as will now be shown.

Applicants' independent Claim 1 specifies limitations of:

"detecting, by a user input monitor, that a user has swiped across an element of a rendered representation of an electronic object in a particular manner,

comparing the particular manner of the swiping, responsive to the detecting, to previously-defined settings that specify what manner of swiping indicates that the user is dynamically identifying a user-defined organizing criterion" (Claim 1, lines 3 - 8, emphasis added).

Independent Claims 18 and 19 specify similar limitations. See Claim 18, lines 4 - 9 and Claim 19, lines 5 - 10.

As the Federal Circuit stated in *W.L. Gore & Associates v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984), "Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." (emphasis added). Section 2131 of the MPEP, "Anticipation ...", includes a subheading "To Anticipate a Claim, the Reference Must Teach Every Element of the Claim". The text under this subheading begins by stating "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference", citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), emphasis added.

With reference to independent Claim 1, Kenyon has no discussion, nor any suggestion, of a user "swip[ing] across" anything, and in particular, swiping across an element of a rendered representation (Claim 1, lines 3 - 4). Kenyon also has no discussion, nor any suggestion, of

Serial No. 09/973,883

-9-

Docket RSW920010194US1

“detecting” that a user has swiped across an element of a rendered representation (Claim 1, lines 3 - 4).

Furthermore, Kenyon has no discussion, nor any suggestion, of “comparing the particular manner of the [detected] swiping ... to previously-defined settings that specify what manner of swiping indicates that the user is dynamically identifying a user-defined organizing criterion” (Claim 1, lines 5 - 8, emphasis added). (Note that while the clarified claim language is specified here, this is a clarified wording of the prior claim language, and Kenyon has no teaching or suggestion of the present claim language or of that prior claim language.)

Kenyon also fails to teach limitations of a number of Applicants’ dependent claims. For example, dependent Claim 3 specifies “repeatedly swiping across” (Claim 3, line 2). This claim is discussed on Page 4 of the Office Action, where col. 5, lines 14 - 37 of Kenyon are cited. Applicants respectfully submit that this cited text has no discussion, nor any suggestion, of “repeatedly” swiping anything.

Dependent Claims 11 - 13 specify “swip[ed] across ... at least twice” (Claim 11, lines 2 - 3). These claims are discussed on Pages 5 - 6 of the Office Action, where Fig. 1 and col. 4, lines 54 - 65 of Kenyon are cited for each claim. Applicants respectfully submit that this cited figure and text have no discussion, nor any suggestion, of swiping across anything “at least twice”.

Dependent Claim 15 specifies "passing his or her eyes repeatedly over ..." (Claim 15, line 3), and dependent Claim 16 specifies "swiped across multiple times" (Claim 16, line 2). These claims are discussed on Page 6 of the Office Action, where col. 4, lines 12 - 44 of Kenyon are cited for each claim. Applicants respectfully submit that this cited figure has no discussion, nor any suggestion, of "passing eyes repeatedly" across anything or swiping across anything "multiple times".

Accordingly, it has been demonstrated that the cited reference does not teach "each and every element" of the claim language, in violation of the above-cited MPEP Section 2131 and the holding in *W.L. Gore & Associates*. The Office Action therefore fails to make out a *prima facie* case of anticipation as to independent Claims 1, 18, and 19 and (at least) dependent Claims 3, 11 - 13, and 15 - 16.

Because a *prima facie* case of anticipation has not been made out, independent Claims 1, 18, and 29 are deemed patentable. See *In re Oetiker*, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992), which stated:

If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent.

Having failed to establish that the independent claims are anticipated, dependent Claims 2 - 8 and 10 - 17 are deemed patentable (at least) by virtue of the allowability of the independent claims.

Accordingly, the Examiner is respectfully requested to withdraw the §102 rejection of all remaining claims. And, because a *prima facie* case of anticipation has not been made out, the Examiner is respectfully requested to withdraw the finality of the Office Action.

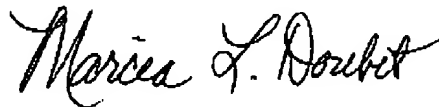
### III. Allowable Subject Matter

Paragraph 6 of the Office Action states that Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form to include all limitations of the base claim and any intervening claims. Applicants respectfully submit that independent Claim 1, from which Claim 6 depends, is allowable as currently presented.

### IV. Conclusion

Applicants respectfully request reconsideration of the pending rejected claims, withdrawal of the finality of the Office Action, withdrawal of all presently outstanding rejections, and allowance of all remaining claims at an early date.

Respectfully submitted,



Marcia L. Doubet  
Attorney for Applicants  
Reg. No. 40,999

Customer Number for Correspondence: 43168  
Phone: 407-343-7586  
Fax: 407-343-7587

Serial No. 09/973,883

-12-

Docket RSW920010194US1